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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/089,841 | 09/30/2002 | Susanne Brakmann | B1180/20005 | 5272 |
| 3000 | 7590 | 01/04/2006 | EXAMINER | |
| CAESAR, RIVISE, BERNSTEIN, COHEN & POKOTILOW, LTD. 11TH FLOOR, SEVEN PENN CENTER 1635 MARKET STREET PHILADELPHIA, PA 19103-2212 | | | HANDY, DWAYNE K | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1743 | |
| DATE MAILED: 01/04/2006 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/089,841 | Applicant(s) BRAKMANN ET AL. | |
| | Examiner Dwayne K. Handy | Art Unit 1743 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-24 and 27-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-24 and 27-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Inventorship

1. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 17-20, 22-24 and 29-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peters (4,299,920) in view of Elkins (4,441,793).

Peters shows a receptacle for cell cultures or biological samples. The device is comprised of a base plate (3) and wall section (1) having a number of wells (2). Peters states the wall section may be comprised of several materials including silicone rubber (column 2, lines 8-35). Materials for the base plate – including glass – are disclosed in column 3, lines 10-13. A cover element (not shown) is disclosed in column 3, lines 33-50. Peters does not teach a cover having openings. Peters instead recites a cover that “may be held to the wall section (1) by adhesion and thus close the chamber in the same way that the base is closed on its underside” (col. 3, lines 43-46).

Elkins teaches a microscopic evaluation slide. The device is best shown in Figure 3 and described in column 2. The device has a base layer (23), a wall layer (24), and a cover layer (25) with openings (17-22). It would have been obvious to combine the cover with openings from Elkins with the device of Peters. One would add the cover with openings to allow for the addition or removal of liquids in the chambers as suggested by Elkins (col. 3, lines 24-26).

4. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Peters (4,299,920) and Elkins (4,441,793), as applied to claims 17-20, 22-24 and 29-33 above, and further in view of Muramatsu (6,645,434). Peters and Elkins, as combined above, teach every element of claim 21 except for a base thickness of about 150 microns.

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Muramatsu teaches an observation plate comprised of a smooth glass plate having a crystalline thin layer on the upper surface. The glass used in Muramatsu is "nearly 0.17 mm" and when combined with the crystalline layer, the overall thickness is less than 0.25 mm. This dimension allows for the examination of the slide by an oil-immersed or water-immersed type objective lens of an inverting microscope (column 2, lines 53-67). It would have been obvious to one of ordinary skill in the art, then, to combine the thickness teaching from Muramatsu with the combined device of Peters and Elkins. One would use the thickness suggested by Muramatsu to allow for examination of the slide by an oil-immersed or water-immersed type objective lens of an inverting microscope.

5. Claims 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peters (4,299,920) and Elkins (4,441,793), as applied to claims 17-20, 22-24 and 29-33 above, and further in view of Brown (6,037,168). Peters and Elkins, as described above, teach a device having an upper elastomeric layer with holes that form wells when placed on another, lower base layer. These references do not teach an upper layer having channels that comprise fluid lines, however. Brown also teaches a device that is comprised of an upper layer (24) with holes (26) that form wells when placed on another, lower base layer (22). The upper layer of Brown may also include channels that connect the wells. This allows for the exchange of fluids between the wells (column 14, lines 14-28). It would have been obvious to combine the channels of Brown with the

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combined device of Peters and Elkins. One would add the channels to the elastomeric layer in order to allow for the exchange of fluids between wells as suggested by Brown.

Response to Arguments

6. Applicant's arguments, filed 10/20/2005, with respect to the 102 rejection(s) under Peters, Elkins, and Brigati have been fully considered and are persuasive. Therefore, the 102 rejections have been withdrawn. The Examiner agrees with Applicant's assertion that Peters fails to teach a cover. The Examiner also agrees with Applicant's claim that Elkins does not teach a compartment layer that automatically adheres with the base. The base of Elkins requires heat or adhesive. The Examiner respectfully disagrees with Applicant's assertion that Brigati does not teach an automatically adhering layer – but this point is moot in light of the current amended claim since Brigati does not disclose a cover.

Upon further consideration, a new ground(s) of rejection is made in view of Peters and Elkins. This was described above in paragraph 3. The Examiner believes the addition of the cover with openings from Elkins to the device of Peters yields a device that meets the limitations of claim 17.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

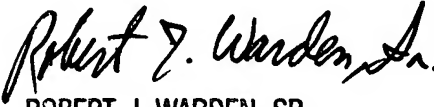
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwayne K. Handy whose telephone number is (571)-272-1259. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DKH
December 27, 2005


ROBERT J. WARDEN, SR.
SUPERVISORY PATENT EXAMINER
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